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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,686	04/05/2006	Reinhold Schwalm	287738US0PCT	4204

22850 7590 11/12/2009  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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GILLESPIE, BENJAMIN

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,686	<b>Applicant(s)</b> SCHWALM ET AL.	
	<b>Examiner</b> BENJAMIN J. GILLESPIE	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 9-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2009 has been entered.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-6 and 9-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Baccei (U.S. Patent 4,309,526) in view of Schwalm et al (U.S. Patent 6,459,459).

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4. **Regarding claim 1:** The rejection has been previously set forth in paragraphs 5-7 of the final rejection mailed 6/23/2009 and are herein incorporated by reference.
5. **Regarding claims 2 and 6:** The rejection has been previously set forth in paragraph 8 of the final rejection mailed 6/23/2009 and is herein incorporated by reference.
6. **Regarding claim 3:** The rejection has been previously set forth in paragraph 9 of the final rejection mailed 6/23/2009 and is herein incorporated by reference.
7. **Regarding claim 4:** The rejection has been previously set forth in paragraph 10 of the final rejection mailed 6/23/2009 and is herein incorporated by reference.
8. **Regarding claims 5 and 23:** The rejection has been previously set forth in paragraph 11 of the final rejection mailed 6/23/2009 and is herein incorporated by reference.
9. **Regarding claims 9-22:** The rejection has been previously set forth in paragraph 11 of the final rejection mailed 6/23/2009 and is herein incorporated by reference.
10. **Regarding claims 1 and 24:** The rejection has been previously set forth in paragraphs 13-15 of the final rejection mailed 6/23/2009 and are herein incorporated by reference.
11. **Regarding claim 25:** Component (Aii) may be hydroxylethyl acrylate (Baccei; col 5 lines 1-13).

***Response to Arguments***

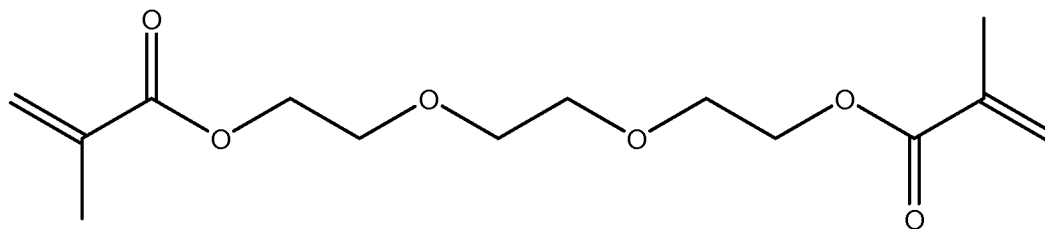
12. Applicant's arguments filed 9/30/2009 have been fully considered but they are not persuasive. Applicants argue the claimed invention has not been rendered obvious by Baccei ('526) in view of Schwalm et al ('459) because Baccei only teach urethane acrylates based on triethylene glycol (TRIEGMA). Applicants go on to state that this is not the same as required by claim 1 because TRIEGMA contains two ethylenically unsaturated groups and the claimed

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urethane acrylate instead requires component a2), which has “only one ethylenically unsaturated double bond”.

13. In response, applicants have apparently misinterpreted the teachings of Baccei.

TRIEGMA has the structure:



triethyleneglycol dimethacrylate

14. and therefore does not possess free hydroxyl groups that react with the isocyanate-functional prepolymer. Moreover, example 1 teaches that the isocyanate-functional prepolymer is reacted with **mono-functional acrylates**, which is the same as required by applicants' amended claim 1 (See Baccei column 7 lines 51-52).

15. The TRIEGMA acts as a reactive diluents – see column 7 line 40 of Baccei – and is not chemically incorporated into the urethane acrylate intermediate. TRIEGMA does not correspond to applicants claimed a2). It corresponds to the claimed component c): “a bifunctional... ester of an  $\alpha,\beta$ -ethylenically unsaturated carboxylic acid with diol or polyol”. Thus, the prior art still satisfies the claimed composition.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm.

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17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J Gillespie/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796